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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,085	07/12/2001	Richard L. House	062891.0555	1874

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EXAMINER
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KNOLL, CLIFFORD H

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/904,085

**Applicant(s)**

HOUSE, RICHARD L.

**Examiner**

Clifford H. Knoll

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office Action is responsive to communication filed 12/9/2004. Currently claims 1-37 are pending.

#### ***Affidavit – CFR 1.131***

1. *The Declaration filed on 12/9/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Liva reference.*

#### **Diligence**

2. *The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Liva reference to either a constructive reduction to practice or an actual reduction to practice.*

From MPEP 715.07(a):

*In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).*

Irrespective of whether conception has been established, in the interest of compact prosecution the Examiner notes that the evidence submitted is insufficient to establish diligence from a date prior to the effective date of the Liva (5/30/2001) to the date of filing (7/12/01).

Also from MPEP 715.07(a):

*Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence).*

#### Diligence of Inventor

Beginning with the priority date of Liva (5/30/2001), the declaration as a whole fails to present affirmative steps that establish due diligence between 5/30/2001 and the constructive reduction to practice, which coincides with the filing of the application (7/12/2001).

The declaration alleges that the inventor "finalized paperwork in anticipation of filing"; however, this does not allege diligence for the period; moreover, even were it alleged, "a statement that the subject matter 'was diligently reduced [constructively, in the instant case] to practice' is not a showing but a mere pleading" (see MPEP §2138.06):

"The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses". In particular, "diligence requires that applicants must be specific as to dates and facts" (MPEP §2138.06).

#### Diligence of Attorney

In the Response the Attorney has provided additional remarks pertinent to the determination of diligence that do not form part of a declaration. Although these

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remarks are not presented properly in a declaration as per CFR 1.131, the Examiner considers them.

Turning to Attorney remarks, Attorney alleges "reasonable diligence" based on the facts of:

*"finalizing of the paperwork, among other items, included making minor edits to the application (See, e.g., a comparison of the draft drawings in Exhibit A of the Declaration and the drawings of the Application as filed in the File Wrapper); preparing patent application transmittal paperwork (See paperwork filed in application in the File Wrapper); transmitting a final version of the application to the inventor for execution (See July 2, 2001, letter in Exhibit A for the Declaration); and signing the Application's Declaration and Application's Assignment (See the July 10, 2001, execution date of both documents in the File Wrapper)"*

The draft drawings (prior to 5/30/2001) in Exhibit A are used as evidence to support the allegation of minor editing; however the Attorney fails to distinctly point out those features which differ between the draft drawings and the Drawings filed with the Application. The other evidence relied upon pertinent to the establishment of diligence is the letter of July 2, 2001 in Exhibit B.

However, these facts fail to establish reasonable diligence on the part of the Attorney between the dates of 5/30/2001 and 7/12/2001. From MPEP 2138.06:

*"Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence"*

In conformance with this citation of MPEP §2138.06, allegations of fact that tend to support the expeditious processing of the Application on the part of the Attorney may be sufficient to establish diligence on the part of the Attorney. It remains to establish an unbroken period of diligence between 5/30/01-7/12/2001 by relying on affirmative acts and specific dates. There are no affirmative acts and specific dates in the period 5/30/2001-7/02/2001 in the Declaration submitted that would establish an unbroken period of diligence consisting of Attorney, or alternately Inventor, diligence.

### **Conception**

3. *The evidence submitted is insufficient to establish conception of the claimed invention prior to the effective date (4/21/2001) of the Liva reference.*

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The MPEP states (as per 715.07):

*The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be **specifically referred** to in the affidavit or declaration, in terms of what it is relied upon to show....*

*The affidavit or declaration and exhibits must **clearly explain which facts or data applicant is relying on to show completion** of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.") [emphasis added]*

The pertinent evidence for establishing conception is in Exhibit A. The inventor has failed to clearly explain which facts relied upon that establish the conception of the **claimed** invention. It appears that there may be sufficient detail such that a properly crafted Declaration may support conception. However the burden is upon the Applicant to clearly explain **which** details are being used as evidence to establish conception, in order to enable the Examiner to make the legal determination thereof.

### **Summary**

4. *Applicant has failed to provide a showing of evidence to establish the attested date of conception (before 5/30/2001) and has also failed to provide a showing of evidence to establish a period of uninterrupted diligence from the priority date of Liva*

*(5/30/2001) to Applicant's constructive reduction to practice (7/12/2001); in particular, the period 5/30/2001-7/2/2001). Therefore, Applicant's arguments filed 12/9/2004 regarding priority over Liva, used in the rejections under 102 and 103, have been fully considered but they are not persuasive.*

***Claim Rejections - 35 USC § 102***

5. *Claims 1-2, 4-10, 12-15, 17-22, 24-28, 30-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Liva (US 2002/0179720).*

Regarding claim 1, Liva discloses first and second cards in a chassis with input and output nodes (e.g., Figure 8(b), "845", "815"); providing a facilitator card (e.g., Figure 8(b), "825") in the chassis having an input node connectable to the common bus and an output node connectable to an input node (e.g., paragraph [0019], "420"), connecting the input node of the second card to the output node of the redundancy facilitator card (e.g., Figure 8(b), "8252"), connecting the input node of the first card to the output of the first card (e.g., Figure 8(b), "8452"), thereby coupling the input node of the first card to the input node of the second card to provide redundancy (e.g., paragraph [0023]).

Regarding claim 2, Liva also discloses connecting the input node of the second card to the output node of the facilitator card by a cable (e.g., paragraph [0019], "The interconnects between additional I/O card 425...").



Regarding claim 4, Liva also discloses connecting the input node to the output node of the first card after determining a failure has occurred (e.g., paragraph [0022]).

Regarding claim 5, Liva also discloses a line card (e.g., paragraph [0019]).

Regarding claim 6, Liva also discloses a network interface card as the first card (e.g., paragraph [0003]).

Regarding claim 7, Liva also discloses connecting the input node of the second card to the output node of the redundancy facilitator card by a cable and a pair of interface connectors disposed on a backplane (e.g., paragraph [0019]).

Regarding claim 8, Liva also discloses circuitry to perform a function and a switch to connect the input node of the card to either the output node or the circuitry of the card (e.g., paragraph [0022]).

Regarding claim 9, Liva also discloses connecting the input node of the second card to a first interface connector located on a backplane of the chassis and connecting the output node of the facilitator card to a second interface connector located on the backplane (e.g., paragraph [0019], Figure 5).

Regarding claim 10, Liva also discloses connecting the first interface connector to the second interface connector by a cable (e.g., paragraph [0019]).

Regarding claim 12, Liva also discloses connecting the first connector to the second interface connector by conductors formed on the backplane (e.g., paragraph [0019]).

Regarding claim 13, Liva also discloses a portion of the common bus is formed on the backplane of the chassis.

Regarding claim 14, Liva discloses first and second cards in a chassis (e.g., Figure 8(b), "845", "815"), providing a test card (e.g., paragraph [0025]), connecting the input node of the second card to the output node of the test card (e.g., Figure 5), connecting the input node of the first card to the associated output node of the first card and connecting the input node of the test card to the test circuitry (e.g., paragraph [0019]).

Regarding claim 15, Liva also discloses connecting the input node of the second card to the output node of the test card by a cable (e.g., paragraph [0019]).

Regarding claim 17, Liva also discloses a line card (e.g., paragraph [0019]).

Regarding claim 18, Liva also discloses a network interface card as the first card (e.g., paragraph [0003]).

Regarding claim 19, Liva also discloses connecting the input node of the second card to the output node of the test card by a cable and a pair of interface connectors, the interface connectors disposed on a backplane of the chassis (e.g., paragraph [0019]).

Regarding claim 20, Liva also discloses circuitry to perform a function and a switch to connect the input node of the card to either the output node or the circuitry of the card (e.g., paragraph [0022]).

Regarding claim 21, Liva also discloses connecting the input node of the second card to the output node of the test card by a cable and a pair of interface connectors disposed on a backplane and connecting the output node of the test card to a second interface connector located on the backplane (e.g., paragraph [0019]).

Regarding claim 22, Liva also discloses connecting the first interface connector to the second interface connector by a cable (e.g., paragraph [0019]).

Regarding claim 24, Liva also discloses connecting the first interface connector to the second interface connector by conductors formed on the backplane (e.g., paragraph [0019]).

Regarding claim 25, Liva also discloses the common bus portion formed on a backplane (e.g., paragraph [0019]).

Regarding claim 26, Liva also discloses a chassis, first and second cards with logic, input and output nodes (e.g., paragraph [0019]), a switch operable to connect the input node of the card to either the output node of the card or the card logic (e.g., Figure 5), a facilitator card disposed in one of the slots having input and output nodes and a first connector operable to connect the input node to the output node (e.g., paragraph [0019], "420"), where the backplane comprises a bus connected to the output nodes of the cards and the input node of the facilitator card and a second connector connecting the output node of the facilitator card to the input node of the second card (e.g., Figure 5).

Regarding claim 27, Liva also discloses the second connector comprises a cable (e.g., paragraph [0019]).

Regarding claim 28, Liva also discloses the pair of interface connectors (e.g., paragraph [0019]).

Regarding claim 30, Liva also discloses the switch (e.g., Figure 5).

Regarding claim 31, Liva also discloses a conductor connecting the input node of the facilitator card to the output node of the facilitator card (e.g., Figure 5).

Regarding claim 32, Liva also discloses the test circuitry and a switch further operable to selectively connect the input node of the3 facilitator card to the test circuitry (e.g., paragraph [0022]).

Regarding claim 33, Liva also discloses a line card (e.g., paragraph [0019]).

Regarding claim 34, Liva also discloses a network interface card as the first card (e.g., paragraph [0003]).

Regarding claim 35, Liva discloses first and second cards (e.g., Figure 8(b), "845", "815"), and means for selectively connecting the input node of the first card to the output node of the first card (e.g., Figure 8(b), "8452") and means for connecting the output node of the first card to the input node of the second card (e.g., paragraph [0023]).

Regarding claim 36, Liva also discloses a line card (e.g., paragraph [0019]).

Regarding claim 37, Liva also discloses a network interface card as the first card (e.g., paragraph [0003]).

***Claim Rejections - 35 USC § 103***

6. *Claims 3, 11, 16, 23, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liva as applied above, further in view of Heilmann (US 2003/0112940).*

Regarding claims 3, 11, 16, 23, and 29, Liva also discloses the use of a multi-pin pair cable, but does not expressly mention the particular implementation of a twenty-five pair cable; however Heilmann discloses this detail (e.g., paragraph [0042]). It would have been obvious to combine Heilmann with Liva because Heilmann teaches the advantages of using a conventional cable arrangement (e.g., paragraph [0028]) in implementing the multi-pin pair cable of Liva. Therefore, it would be obvious to one of ordinary skill in the art to combine Heilmann with Liva at the time the invention was made.

***Response to Arguments***

Applicant's arguments filed 12/9/04 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant argues that Liva fails to disclose "connecting the input node of the first card to the associated output node of the first card" (p. 11); however, this particular feature is seen in Figure 5, where the output of card "500" is connected to the input of the facilitator card ("505" and intermediaries, see Figure 8(b))

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via the switch "530". The explicit details of the connection are shown in Figures 6 and 8(b), which shows how the input node ("RF in") is connected to the output node "622" in order to provide redundancy. Although "622" is labeled as "B/U Bus In" in Figure 6, it is an output because it couples to the input of the second card, as the specification discloses: "the Back-up In 622 would be coupled to the RF In (thus enabling upstream connectivity of the redundant line card with the I/O card 600)" (para. 32).

Applicant notes that the Response to Arguments of the previous Office Action of 6/10/04 referred to Liva's Provisional Application. It is correct that these particular details were also disclosed in the provisional to Liva in the course of responding to arguments in the Office Action of 6/10/04. In the Action, the Examiner stated: "*As Applicant raises the issue of inadequate disclosure in the provisional Application, Examiner has based his response on disclosure from the provisional Application*" (pp. 8-9). In order to further clarify the interpretation of Liva, whose features are based on the provisional for priority, additional citations are provided to Liva in the above maintained rejection. The citations to the provisional application provided in the Response to Arguments section of the 6/10/04 Office Action are not intended for the purposes of rejection, but do support the priority of those features relied upon in Liva to reject the instant Application.

Applicant further argues that such a limitation is not supported in the provisional application on which Liva relies. Applicant rightly notes that "the boxes labeled Line Card #1' and 'Line Card #2' do not correspond to circuitry on a line card for which redundancy is provided. Rather it is circuitry on an I/O card that may be connected to

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in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clifford H. Knoll whose telephone number is 571-272-3636. The examiner can normally be reached on M-F 0630-1500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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line cards" (p. 11). However, the Examiner is not relying on the Liva's associated line card to anticipate the "first card", rather, the claimed "first card" is an I/O card. The claims do not exclude this interpretation of the recited "first card". This particular feature is found also in Liva and has been provided in the rejection supra in the form of additional citations.

Examiner notes that a "line card" is specifically recited as part of claim 5; however the "line card" is "provided", a feature that is adequately disclosed by the association (i.e., "provision") in Liva of a line card with the I/O card.

Regarding claim 35, Applicant argues that "means for selectively connecting..." and the "means for connecting" are not clearly shown in the recited Figure; however, this argument is treated in the response supra regarding parallel claim 1. Additional citations from the interpretation established in rejecting claim 1 have been added to the explanation of the rejection of claim 35 to make these features explicit and hopefully more clear.

### ***Conclusion***


This is a continuing Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8/2/05